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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/335,127	06/17/1999	WILLIAM PATRICK COAN	113444	6119

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KENYON & KENYON
1500 K STREET, N.W., SUITE 700
WASHINGTON, DC 20005

EXAMINER

LEE, JOHN J

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 07/15/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/335,127

Applicant(s)

COAN ET AL.

Examiner

JOHN J LEE

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments/Amendment

1. Applicant's arguments received on April 23, 2003 have been fully considered but they are not persuasive because the combined teaching of all the cited references reads on all the claims as set forth in the pervious rejection. Therefore, the finality of this Office Action is deemed proper.

Contrary to the assertions at page 2 of the Argument, claims 1 – 20 are not patentable.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's arguments, the recitation “determining whether non-latency-dependent data and wireless communication” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Re claims 1, 3, 7, 9, 13, 15, and 19: Applicant argues that the combination of Kumar et al. (US Patent number 6,434,367) and Griefer (US Patent number 5,615,213) do not teach the claimed invention “the data is appropriate for transmission to a base station over a digital control channel, and if the data is not appropriate for transmission over a digital control channel, transmitting the data over a traffic channel”. However, The Examiner respectfully disagrees with Applicant’s assertion that the combination of Kumar and Griefer do not teach the claimed invention. Contrary to Applicant’s assertion, the Examiner is of the opinion that Kumar teaches communicating data with a dedicated control channel or supplemental/traffic channel between user’s device/mobile station and base station (see Fig. 7, 8 and column 11, lines 57 – column 12, lines 17). Moreover, Griefer teaches data sends over traffic channel (B channel) as the message length is greater than predetermined limit size or if the message length is not greater than predetermined limit size, the data transmits over control channel (D channel) (see Fig. 3, steps 102 through 114), regarding the claimed limitation. More specifically, combination of Kumar and Griefer teach according to depend on the condition (predetermined limit size), transmitting the data over control channel or traffic channel in communication network. The motivation dose so would be to minimize the network resource in communication system.

Applicant’s attention is directed to the rejection below for the reasons as to why this limitation is not patentable.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1 – 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. (US Patent number 6,434,367) in view of Griefer (US Patent number 5,615,213).

Regarding **claim 1**, Kumar discloses that a method for wireless communication for non-latency dependent data, the method comprising:

receiving data for transmission to a base station (Fig. 8, 9) (column 6, lines 27 – 64);

if the data is not appropriate for transmission over a digital control channel, transmitting the data over a SCH (supplemental channel) (column 10, lines 27 – column 12, lines 19 and column 16, lines 3 – column 17, lines 8).

Kumar does not specifically disclose the limitation “if the data is not appropriate for transmission over a digital control channel, transmitting the data over a traffic channel and determining whether the data is appropriate for transmission over a digital control channel”. However, Griefer discloses the limitation “if the data is not appropriate for transmission over a digital control channel, transmitting the data over a traffic channel and determining whether the data is appropriate for transmission over a digital control channel” (Fig. 3 and column 6, lines 6 – column 7, lines 50). It would have been obvious

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to one having ordinary skill in the art, at the time the invention was made to modify the Kumar system as taught by Grierfer. The motivation does so would be to minimize the network resource in communication system.

Regarding **claim 2**, Kumar does not specifically disclose the limitation “the determining includes determining whether the data is less than a predetermined size”. However, Grierfer discloses the limitation “the determining includes determining whether the data is less than a predetermined size” (Fig. 3 and column 6, lines 6 – column 7, lines 50). It would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the Kumar system as taught by Grierfer. The motivation does so would be to minimize the network resource and enhance the managing system in communication system.

Regarding **claim 3**, Kumar and Grierfer disclose all the limitation, as discussed in claims 1 and 2.

Regarding **claim 4**, Kumar and Grierfer disclose all the limitation, as discussed in claims 1 and 3.

Regarding **claim 5**, Kumar discloses all the limitation, as discussed in claims 1 and 2.

Regarding **claim 6**, Kumar and Grierfer disclose all the limitation, as discussed in claims 1 and 2.

Regarding **claim 7**, Kumar and Grierfer disclose all the limitation, as discussed in claims 3 and 4. However, Kumar does not specifically disclose the limitation “monitoring network conditions for conditions favorable for transmission”. However, Grierfer

discloses the limitation “monitoring network conditions for conditions favorable for transmission” (Fig. 3 and column 6, lines 6 – column 7, lines 50). It would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the Kumar system as taught by Grier. The motivation does so would be to minimize the network traffic resource over the network.

Regarding **claim 8**, Kumar and Grier disclose all the limitation, as discussed in claims 3 and 6.

Regarding **claim 9**, Kumar and Grier disclose all the limitation, as discussed in claims 3 and 7. However, Kumar does not specifically disclose the limitation “a memory coupled to said processor, said memory storing instructions adapted to be executed on said processor”. However, Grier discloses the limitation “a memory coupled to said processor, said memory storing instructions adapted to be executed on said processor” (Fig. 2 and column 3, lines 62 – column 5, lines 57). It would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the Kumar system as taught by Grier. Doing so would enhance the transmitting data adaptability in communication system.

Regarding **claim 10**, Kumar and Grier disclose all the limitation, as discussed in claims 3 and 4.

Regarding **claim 11**, Kumar and Grier disclose all the limitation, as discussed in claims 3 and 5.

Regarding **claim 12**, Kumar and Grier disclose all the limitation, as discussed in claims 3 and 6.

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Regarding **claim 13**, Kumar and Griener disclose all the limitation, as discussed in claims 7 and 9.

Regarding **claim 14**, Kumar and Griener disclose all the limitation, as discussed in claims 6 and 13.

Regarding **claim 15**, Kumar and Griener disclose all the limitation, as discussed in claims 3 and 9.

Regarding **claim 16**, Kumar and Griener disclose all the limitation, as discussed in claims 3 and 4.

Regarding **claim 17**, Kumar and Griener disclose all the limitation, as discussed in claims 3 and 5.

Regarding **claim 18**, Kumar and Griener disclose all the limitation, as discussed in claims 3 and 6.

Regarding **claim 19**, Kumar and Griener disclose all the limitation, as discussed in claims 7 and 9.

Regarding **claim 20**, Kumar and Griener disclose all the limitation, as discussed in claims 3 and 6.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ahuja et al. (US Patent number 6,222,837) discloses Internet Service via ISDN.

Wrede et al. (US Patent number 5,937,040) discloses Using a D-Channel for Displaying User Data.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6606 (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(703) 306-5936**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Nay Aung Maung**, can be reached on **(703) 308-7745**. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L
July 1, 2003

John J Lee


NAY MAUNG
PRIMARY EXAMINER